

REMARKS

Careful examination of the application is sincerely appreciated.

Applicant wishes to thank the Examiner for the indication of the allowed claims and allowable subject matter.

According to the Office Action, claims 1, 15, 16, 18, 20, 22-24, 26, 27, 29, 30, 35, 43, 44, 48 and 49 were rejected under 35 U.S.C. §103(a) as being obvious over US Patent 6,337,855 (hereinafter “Malkamaki”) in view of US Published Application US 2003/0026223 (hereinafter “Eriksson”).

Further to the Office Action, claims 8, 9, 12-14, 36-42 and 50-52 were allowed.

Still further to the Office Action, claims 2-7, 17, 19, 21, 25, 28, 33, 34 and 46 were indicated to contain allowable subject matter.

To expedite the prosecution of the application and without conceding any statements or waiving any arguments in the Office Action, Applicant’s claims are amended as follows in response to the Office Action.

The allowable subject matter of claim 2 is incorporated into independent claim 1, thereby making claim 1 and dependent claims 3-7 allowable.

Similarly, the allowable subject matter of claim 23 is incorporated into independent claim 22, thereby making claim 22 and dependent claims 24-28 allowable.

It is submitted that independent claims 15, 29 and 43 contain, among other things, Applicant’s feature of “wherein the time-varying signal changes frequency during each of a plurality of periods, wherein the frequency of the time-varying signal changes from one period to

a subsequent period in a predetermined sequence of frequencies within a channel on which the received signal is received.” According to the Office Action, this feature of claims 1 and 15 was found to overcome the prior art of record. It is not clear as to why the examiner failed to find claims 15, 29 and 43 not in condition for allowance. If the examiner maintains the rejections, a detailed explanation is respectfully requested with respect to claims 15, 29 and 43, as well as the claims dependent therefrom, as to each and every feature therein allegedly rendered obvious by the combination of Malkamaki and Eriksson.

The combination of Malkamaki and Eriksson fails to teach or suggest, among other things, Applicant’s feature of “wherein the time-varying signal changes frequency during each of a plurality of periods, wherein the frequency of the time-varying signal changes from one period to a subsequent period in a predetermined sequence of frequencies within a channel on which the received signal is received.” Clearly, Malkamaki is completely silent on frequency changes as admitted by the examiner in the Office Action. Eriksson fails to cure this deficiency as he merely discloses a conventional GSM-based training sequence positioned in the middle of the burst (see FIG. 3 and paragraph [0007] as relied upon in the Office Action). Eriksson’s paragraph [0011], as relied upon in the Office Action, is directed to conventional frequency hopping concept in GSM, as fully described in the 3GPP specification cited by Eriksson. Hence, Eriksson is deficient in teaching or suggesting Applicants’ above-mentioned novel feature.

If the examiner still believes otherwise and maintains the rejections based on the same references, he is respectfully requested 1) to **specifically point out** – using column/paragraph, line numbers and reference numerals/characters – where such a disclosure can be found in

Malkamaki and/or Eriksson; 2) to provide an affidavit stating facts within his personal knowledge; or 3) to provide a prior art reference stating the same, because the examiner's interpretation of Malkamaki and/or Eriksson can't be supported by the record.

It is respectfully submitted that the Examiner failed to establish a *prima facie* case of obviousness. The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. 103 is set forth in MPEP § 706.02(j):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Analyzing the references according to the above roadmap, first the examiner offered an unsupported, conclusory remark that "it would have been obvious to one skilled in the art at the time the invention was made to produce a modulated signal on a plurality of frequencies to prevent the degradation of the signal." It is not clear what the basis was for such an assertion. There is absolutely no motivation or suggestion to combine the references (Malkamaki explicitly refers to a single frequency only for his training sequence), except on the basis of the

impermissible hindsight and knowledge gleaned from Applicants' invention. Such a practice is prohibited by the applicable law. Picking and choosing elements from various references, while disregarding each reference as a whole, is clearly prohibited by the courts and cannot possibly be sanctioned by the USPTO.

Second, the examiner failed to indicate a reasonable expectation of success and whether the prior art references are combinable.

Third, Malkamaki and Eriksson, even when combined, do not teach all of the Applicant's features as recited in claim 15. Please see the above discussion.

Therefore, the cited references, separately or in combination, fail to render obvious the claimed invention, because at least one of the above-identified criteria is not met. The claimed invention, according to claim 15, is thus distinguishable over the cited references.

At least for the above reasons, Applicant submits that the rejection of claim 15 has been overcome and can no longer be sustained. Applicant respectfully requests withdrawal of the rejection and allowance of the claim.

Analysis of independent claims 22, 29 and 43 is analogous to the one of claim 15, as presented hereinabove. To avoid repetition, claims 22, 29 and 43 will not be discussed in detail with the understanding that they are patentable at least for the same reasons as claim 15. Applicants, therefore, respectfully request withdrawal of the rejection and allowance of claims 22, 29 and 43.

Claims 16, 18, 20, 24, 26, 27, 30, 35, 44, 48 and 49 depend from independent claims, which have been shown to be allowable over the prior art references. Accordingly, claims 16,

18, 20, 24, 26, 27, 30, 35, 44, 48 and 49 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein. Applicant submits that the reason for the rejection of claims 16, 18, 20, 24, 26, 27, 30, 35, 44, 48 and 49 has been overcome and respectfully requests withdrawal of the rejection and allowance of the claims.

In view of the above amendments and remarks, it is believed that the present application is in condition for allowance, and an early notice thereof is earnestly solicited. However, if for any reason this application is not considered to be in condition for allowance, the Examiner is respectfully requested to call the undersigned attorney at the number listed below prior to issuing a further Action.

Please charge any additional fees associated with this application to Deposit Account No. 14-1270.

Respectfully submitted,

January 3, 2007

By /Larry Liberchuk/
Larry Liberchuk, Reg. No. 40,352
Senior IP Counsel
914-333-9602